



Atty. Docket No. 0579-1036

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Lucien AMIOT and Barry MOSTELLER

Serial No. 10/816,827

Group 2833

Filed April 5, 2004

/
MICROCIRCUIT CARD ATTACHED TO AN
ADAPTER BASE, CARD BASE AND
MANUFACTURING METHOD

PETITION FOR RETROACTIVE LICENSE UNDER 35 USC 184

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 28, 2005

Sir:

In accordance with 37 CFR \$5.14(a) and \$5.25, applicants hereby petition for a retroactive license under 35 USC 184. The present petition is requested in connection with an existing U.S. application. The application number, filing date, inventors, and title of such U.S. application are identified in the caption of the present petition.

In accordance with 37 CFR \$5.25(a)(1), a list of each foreign country in which the unlicensed patent application material was filed consists exclusively of France.

As required by 37 CFR \$5.25(a)(2), the material in question was filed in France on September 30, 2003.

In accordance with 37 CFR \$5.25(a)(3), the present petition includes as attachments verified statements in the form of declarations which, in their totality, are believed to make

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the necessary averments, showings, and explanations required by
37 CFR §5.25(a)(3)(i-iii).

The present petition also includes the fee required by
37 CFR §5.25(a)(4) and defined by 37 CFR §1.17(h). Charge the
fee of \$200 to deposit account No. 25-0120.

Respectfully submitted,

YOUNG & THOMPSON


Eric Jensen, Reg. No. 37,855
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

EJ/fb



PATENTS

0579-1036

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Lucien AMIOT and Barry MOSTELLER

Serial No. 10/816,827

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Filed April 5, 2004

MICROCIRCUIT CARD ATTACHED TO AN
ADAPTER BASE, CARD BASE AND
MANUFACTURING METHOD

DECLARATION OF ERIC JENSEN

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 28, 2005

Sir:

I, Eric Jensen, declare as follows:

In connection with the Petition for Retroactive License supported in part by this declaration, I corresponded with Mr. Bruno Quantin, the attorney representing the applicant in the corresponding French application, and the declarant in the declaration that accompanies this one.

Mr. Quantin's declaration evidences an execution date of June 30, 2004. This declaration was received by Young & Thompson via facsimile sent July 16, 2004.

Mr. Quantin's declaration was unintentionally misdirected within Young & Thompson, however. On information and belief, it appears that Mr. Quantin's declaration was associated with Young & Thompson's file for this case as an assignment was being filed for recordation with the United States Patent and

Trademark Office. A copy of a telefax to Young & Thompson from the USPTO sent July 31, 2004 and making reference to the recordation request of July 16, 2004 is attached. On information and belief, Young & Thompson's file for this case was reshelfed after reporting the assignment recordation and was not forwarded to an attorney to file the present petition.

The present facts came to light upon receipt of further telefax correspondence from Mr. Quantin of April 22, 2005, which made reference to the present case. A redacted copy of such telefax is also attached.

Accordingly, any delay in acting on the present petition subsequent to July 16, 2004 is entirely unintentional, and is entirely attributable to the facts as averred above.

I declare that all statements made above that are of my own knowledge are true and that all statements made above on information and belief are believed to be true.

I further declare that I have been warned that willful false statements and the like are punishable by fine or

Docket No. 0579-1036
Appln. No. 10/816,827

imprisonment, or both (18 USC 1001) and may jeopardize the validity of the application or any patent issuing thereon.

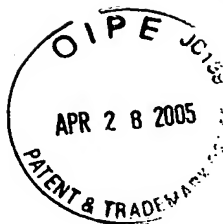
Respectfully submitted,

YOUNG & THOMPSON

A handwritten signature in cursive script, appearing to read "Eric Jensen", written over a horizontal line.

Eric Jensen, Reg. No. 37,855
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
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EJ/fb



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231



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JULY 22, 2004

PTAS

BENOIT CASTEL
745 SOUTH 23RD STREET
ARLINGTON, VA 22202

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 07/16/2004

REEL/FRAME: 014867/0932
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

AMIOT, LUCIEN

DOC DATE: 04/04/2004

ASSIGNOR:

MOSTELLER, BARRY

DOC DATE: 04/06/2004

ASSIGNEE:

OBERTHUR CARD SYSTEMS S.A.
102, BOULEVARD MALESHERBES
PARIS, FRANCE 75017

SERIAL NUMBER: 10816827

FILING DATE: 04/05/2004

PATENT NUMBER:

ISSUE DATE:

TITLE: MICROCIRCUIT CARD ATTACHED TO AN ADAPTER BASE, CARD BASE AND
MANUFACTURING METHOD

014867/0932 PAGE 2

KIMBERLY WHITE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

PATENT ASSIGNMENT

Electronic Version v1.1
Stylesheet Version v1.1

07/16/2004
500002606

SUBMISSION TYPE:	NEW ASSIGNMENT						
NATURE OF CONVEYANCE:	ASSIGNMENT						
CONVEYING PARTY DATA							
<table border="1"><thead><tr><th>Name</th><th>Execution Date</th></tr></thead><tbody><tr><td>Lucien AMIOT</td><td>04/04/2004</td></tr><tr><td>Barry MOSTELLER</td><td>04/06/2004</td></tr></tbody></table>	Name	Execution Date	Lucien AMIOT	04/04/2004	Barry MOSTELLER	04/06/2004	
Name	Execution Date						
Lucien AMIOT	04/04/2004						
Barry MOSTELLER	04/06/2004						
RECEIVING PARTY DATA							
Name:	OBERTHUR CARD SYSTEMS S.A.						
Street Address:	102, Boulevard Malesherbes						
City:	Paris						
State/Country:	FRANCE						
Postal Code:	75017						
PROPERTY NUMBERS Total: 1							
<table border="1"><thead><tr><th>Property Type</th><th>Number</th></tr></thead><tbody><tr><td>Application Number:</td><td>10816827</td></tr></tbody></table>	Property Type	Number	Application Number:	10816827			
Property Type	Number						
Application Number:	10816827						
CORRESPONDENCE DATA							
Fax Number:	(703)685-0573						
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>							
Phone:	(703)521-2297						
Email:	embon@young-thompson.com						
Correspondent Name:	Benoit Castel						
Address Line 1:	745 South 23rd Street						
Address Line 4:	Arlington, VIRGINIA 22202						
NAME OF SUBMITTER:	Patrick Feagans						
Total Attachments: 1 source=2004-07-16 assign#page1.tif							

10816827
CH \$40.00

Facsimile Transmission

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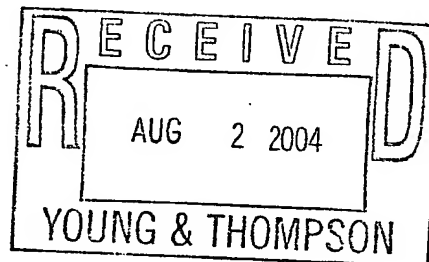
From: Name: USPTO ASSIGNMENT DIVISION
Fax Number:
Voice Phone: 703-308-9723

To: Name: BENOIT CASTEL
Company: 745 SOUTH 23RD STREET
Fax Number: 17036850573
Voice Phone:

Fax Notes:

Pg#	Description
1	Cover Page
2	235.TXT
4	Document 1, Batch 332861

PTAS FAX PROCESSING



Date and time of transmission: Saturday, July 31, 2004 6:07:26 AM
Number of pages including this cover sheet: 04

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Santarelli

Rinuy, Santarelli & Cabinet Bonnet-Thirion

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European Patent, Trademark and Design Attorneys

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Thierry Caen ▲ ■ ■
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Herbert Lewittier ▲ ■ ■
Bruno Quantin ▲ ■ ■

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Isabelle Poujade-Aimol ▲ ■
Muriel Rosenberg ▲ ■
Hélène Stankoff ▲ ■
Oliver Thier ▲ ■
Catherine Ulmann ▲ ■

▲ Conseil en Propriété Industrielle
Industrie (and Property Attorney)

■ Mandataire agréé auprès
de l'Office Européen des Brevets
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YOUNG & THOMPSON
745 South 23rd Street
Arlington, Virginia 22202
U.S.A.

For the attention of Eric Jensen, Esq.

Paris, April 22, 2005

O/Ref.: BIF 116165/WO – BQ/py

Re: A petition for retroactive license under 35 USC 184

Dear Sir:

You might recall that, in connection with U.S. Patent Application No. 10/816,827 (Y/Ref.: 0579-1036, O/Ref.: BIF 116034/US), on July 16, 2004, I sent you a declaration in support of a request for retroactive license to file abroad.

I did not receive any specific comment or report on the filing of this document but assume that this case is in order.

Thanking you in advance, I remain,

Very truly yours,

SANTARELLI

Bruno QUANTIN

Encl.:

- Declaration draft
- Technical note

Siege social / Head office

14 avenue de la Grande Arche - Bâtiment Proteus 237 - 75822 Paris Cedex 17
Tel +33 (0)1 40 55 43 43 Fax +33 (0)1 42 67 56 29 / +33 (0)1 53 81 17 17 - E-mail contact@santarelli.com - www.santarelli.com

Issu de la fusion de Rinuy, Santarelli créée en 1977 et de Cabinet Bonnet-Thirion crée en 1852
Membre of the practices of Rinuy, Santarelli (est. 1977) and Cabinet Bonnet-Thirion (est. 1852)

Société anonyme au capital de 1 533 000 euros - N° Intracommunautaire FR 12 340 66/BBU / VAI Identification Number FR 12 340 66/BBU



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PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Lucien AMIOT and Barry MOSTELLER

Serial No. 10/816,827

Filed April 5, 2004

MICROCIRCUIT CARD ATTACHED TO AN
ADAPTER BASE, CARD BASE AND
MANUFACTURING METHOD

DECLARATION OF BRUNO QUANTIN

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Bruno QUANTIN, declare as follows:

The following statements relate to the subject matter of the U.S. application filed April 5, 2004, naming as inventors Lucien AMIOT and Barry MOSTELLER, and further identified above.

On information and belief, the subject matter in question was not under a secrecy order on September 30, 2003, when the patent application was filed in France, and the subject matter in question is not currently under a secrecy order.

Applicants diligently sought the retroactive license now requested after discovery of the proscribed foreign filing, as evidenced by the following details:

I am an attorney with the Santarelli law firm of Paris, France. Oberthur Card Systems SA (OCS) is a client of

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Santarelli. The Santarelli law firm represents OCS in patent matters.

A first patent application was filed in France on April 3, 2003, such first French application having been assigned No. 03-04156. Such application correctly identifies as the sole inventor Lucien AMIOT. The invention claimed in such application was made entirely in France.

On September 18, 2003, I received a call from Mr. Gérard GALAN. Mr. GALAN is in charge of patent matters for OCS.

Mr. GALAN told me that he had just become aware that an invention had been made by employees of OCS, at least one of which was working in the United States. Mr. GALAN was concerned that the subject matter of such invention was to be publicly disclosed soon, and it was therefore urgent to prepare and file a patent application claiming such invention, in light of the absolute novelty requirements of the patent laws of most countries outside of the United States, including France.

Mr. GALAN told me that he understood this to be the first instance in which an invention owned by OCS had been made within the U.S. subsidiary that employed the U.S. inventor. Mr. GALAN told me that the U.S. subsidiary in question did not have an existing relationship with a U.S. patent attorney. Mr. GALAN told me that the subject of the new invention based at least in part on work done in the United States was related to the subject matter of the first French application filed April 3, 2003.

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On the same day as the telephone call, Mr. GALAN sent to me an email containing the technical details of the invention made at least in part in the United States. Upon reviewing such technical description, I agreed that it was closely related to the subject matter of the earlier French patent application. In light of the similarity in subject matter, I focused my efforts on the preparation and filing of a new French application that would benefit at least in part from the filing date of the earlier French application, and which would be filed in France prior to the public disclosure of such new invention. To this end, I prepared and, on September 30, 2003, filed a second French application disclosing and claiming the invention which, at least in part, was made in the United States.

The subject of the present application has not been the subject of any other patent application except the second French application.

As is our common practice, we made arrangements to obtain patent protection for the subject matter of the second invention outside of France. To this end, we instructed the law firm of Young & Thompson by way of telefax on March 24, 2004 to prepare and file in the United States a new U.S. patent application making a priority claim to both the first and second French applications.

It was only after September 30, 2003, and more specifically in early April 2004, that I discovered that the

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subject matter of the second French application was treated differently under U.S. law than the subject matter of the first French application, whatever its technical field, in light of the fact that it is only the subject matter of the second French application that was made, at least in part, in the United States. I collected relevant information from my file and countercheck same with Mr Gerald GALAN. I sent a telefax to Young & Thompson on May 25, 2004, explaining the facts described above, and requesting that they determine whether the facts as presented above complied with U.S. patent law, and if not to take the necessary steps to remedy the situation.

As supported by the facts described above, I declare that the material of the present U.S. patent application was first filed in France through error and without deceptive intent without first having obtained the license required under 37 CFR §5.11.

I declare that all statements made above that are of my own knowledge are true and that all statements made above on information and belief are believed to be true.

I further declare that I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 USC 1001) and may jeopardize the validity of the application or any patent issuing thereon.

Docket No. 0579-1036
Appln. No. 10/816,827

June 30, 2004
(date)

Bruno Quantin
(signature)

Bruno QUANTIN